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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,559	07/18/2003	Matthew Thomas Adams	13550	4822
7590	11/24/2004			
ORUM & ROTH 53 W. JACKSON BLVD CHICAGO, IL 60604				
EXAMINER RAYFORD, SANDRA M				
ART UNIT		PAPER NUMBER		
1772				

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/622,559

Applicant(s)

ADAMS ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
    4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
        1. ☐ Certified copies of the priority documents have been received.  
        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-14 are pending. Claims 15-20 have been withdrawn.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to labels, classified in class 428, subclass 35.7.
  - II. Claims 15-20, drawn to methods of concealing data\*, classified in class 156, subclass (unknown).

\*Based on preamble of claim 16.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products can be made by injecting the marker below the surface of the object after it is made.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Dr. Marc Patterson and Mr. Keith Orum on 11 October 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14.

5. Applicants must affirm this election when replying to this Office action.

6. Claims 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Litman (US 5,988,500).

Litman teaches magnetic elements containing binders and magnetic particles (col. 5, lines 23-29) and may be polyethylene terephthalate filaments (col. 19, lines 14-17) with magnetic ink impregnated therein (col. 19, lines 28-33). Thermosetting phenolic binders can be used with the magnetic particles (col. 13, lines 21-30). The ink is on each filament or "element" (col. 18, lines 8-9). The elements can be used on or in aircraft parts (col. 13, line 65), and can be included under the head of a bolt (col. 14, lines 22). They may be included in patches (col. 14, lines 4-8), which patches can be polyvinyl chloride/filament/polyvinyl chloride composites (col. 19, lines 46-56).

The examiner deems a filament to be a component of a woven mesh.

An element under the head of a bolt is deemed not to be visually discernible (per claim 11).

10. Claims 1-2, 5, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishida et al (EPO 0552047A1).

Nishida teaches printed matter having marks 2 embedded in paper layers 3 that are concealed by other layers 4, 5 (Figure 1; page 2, line 39 through page 3, line 5).

The marks are magnetic powders in binder resins (page 3, line 53).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over FR-2746191A1 (abstract and Figures 1 and 2) in view of Litman.

The French abstract teaches the use of magnetic particle/glue compositions in books to prevent theft. The glue compositions concealed because it binds the pages to the cover (first paragraph of abstract, Figures 1 and 2). The compositions do not interfere with the books' appearance (Use section of abstract).

A book cover is deemed to be a container.

The abstract fails to teach a composite.

Litman is discussed above.

The references are analogous because they both deal with magnetic marking/labeling for objects.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the magnetic particle/binder compositions of Litman in books of the French abstract to produce a container with magnetic glue integrated with the books' pages.

Art Unit: 1772

The motivation to employ the Litman compositions in the books of the French abstract is found in the use section of the abstract, where maintenance of the books' appearance is taught.

**Conclusion**

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S.M. Nolan-Rayford*  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

10622559(20041123)